The opinion in support of the decision being entered today was **n t** written for publication and is **n t** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

JAN 27 2003

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANDOR NAGY,
RAMESH KRISHNAMURTI,
JOHN A. TYRELL,
LEONARD V. CRIBBS,
MARY COCOMAN,
and
BRADLEY P. ETHERTON

Appeal No. 2001-2095
Application No. 08/872,659

ON BRIEF

Before WALTZ, LIEBERMAN, and POTEATE, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 22 through 35, 37 through 51 and 53 through 73 which are all the claims pending in this application.

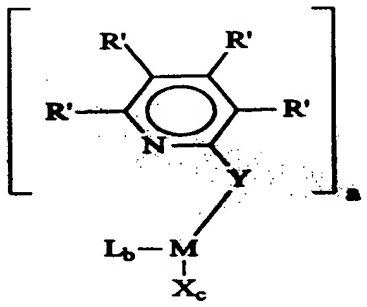
THE INVENTION

The invention is directed to a catalyst comprising pyridinoxy ligands and in some embodiments additionally containing quinolinoxy ligands, said pyridinoxy ligands derived from at least one moiety which is the residue of at least one pyridine moiety and having a specified formula as set forth and described in the following illustrative claim.

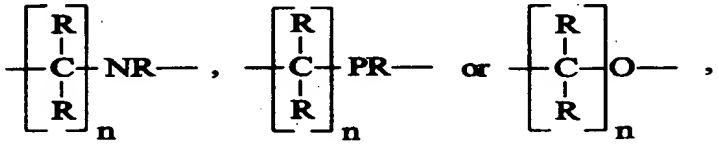
THE CLAIM

Claim 71 is illustrative of appellants' invention and is reproduced below:

71. A catalyst comprising units of the formula:



where Y is -O-, -S-,  , -P-,

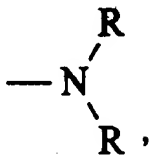


where each R is independently hydrogen, C_{1-6} alkyl, or C_{6-14} aryl;

where each R' is independently R, C_{1-6} alkoxy, C_{7-20} alkaryl, C_{7-20} aralkyl, halogen, or CF_3;

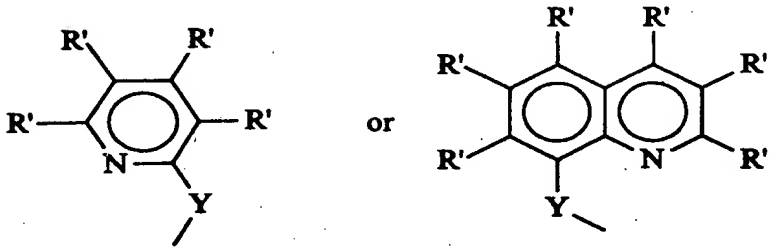
where M is a Group 3 to 10 metal;

where each X is independently halogen, C_{1-6} alkyl, C_{6-14} aryl, C_{7-20} alkaryl, C_{7-20} aralkyl, C_{1-6} alkoxy, or



L is X, cyclopentadienyl, C_{1-6} alkyl-substituted cyclopentadienyl, fluorenyl, indenyl,

or



where n is an integer from 1 to 4;

a is an integer from 1 to 3;

b is an integer from 0 to 2;

the sum of a+b+ $\leq$ 3;

c is an integer from 1 to 6; and

the sum a+b+c equals the oxidation state of M.

THE REFERENCE OF RECORD

As evidence of obviousness, the examiner relies upon the following reference:

Reichle et al. (Reichle)	5,852,146	Dec. 22, 1998 (filed Jun. 27, 1996)

THE REJECTION

Claims 22 through 35, 37 through 51 and 53 through 73 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reichle.

OPINION

We have carefully considered all of the arguments advanced by the appellants and the examiner and agree with the appellants that the rejection of the claims under Section 103(a) is not well founded. Accordingly, we reverse the rejection.

THE REJECTION UNDER SECTION 103(a)

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The examiner relies upon a single reference to reject the claimed subject matter and establish a prima facie case of obviousness. It is the examiner's position that, "[a]s none of the current claims are limited to subject matter which was either fully supported by the parent disclosure or not suggested in REICHLE, all of the claims are properly rejected under 35 U.S.C. § 103 as obvious over REICHLE." See Answer, page 4. We disagree with the examiner's oversimplified

analysis. To establish a prima facie case of obviousness, the examiner must show that the intervening reference to Reichle contains the requisite teachings and suggestion of the subject matter added in the instant continuation-in-part application. As no such analysis is present in the Answer before us, the examiner has failed to establish a prima facie case of obviousness with respect to the claimed subject matter. Furthermore, the appellants have properly argued that, "the burden of going forward to establish a prima facie case is with the Office, not with appellants." See Reply Brief, page 6. Accordingly, we reverse the decision of the examiner.

REMAND TO THE EXAMINER

On consideration of the record we remand the application to the jurisdiction of the examiner for appropriate action in accordance with our findings infra. Upon return of this application to the examiner, the examiner should reconsider the patentability of the claimed subject matter, with respect to at least claim 71 over the individual reference to Reichle.

An analysis of claim 71, with respect to each of the additional limitations present in the aforesaid claim in comparison with the teachings of Reichle and the original Nagy '660 patent would appear to support the position that a prima facie case of obviousness is established by Reichle. The issue to be considered is whether that portion of the claimed

subject matter not described in the parent application, i.e., Nagy '660 is anticipated by or rendered obvious over the teachings and suggestions of the intervening reference to Reichle.

Claim 71 is directed to numerous limitations that do not appear in ipsissima verba in either the specification or the claimed subject matter of the Nagy '660 parent. Specifically, the definition of Y has been expanded to include P containing moieties and C_{6-14} aryl. As to the first group of limitations directed to the definition of Y, we find that the corresponding Y of Reichle is limited exclusively to -O-, oxygen. There is no teaching or suggestion of moieties other than oxygen. Accordingly, the newly inserted limitations of the claimed subject matter falling within the scope of the definition Y need not be given further consideration as no prima facie case of obviousness can be established with respect to moieties neither taught by, nor suggested by Reichle.

Claim 71 further contains a limitation of R' being C_{7-20} alkaryl, C_{7-20} aralkyl. The examiner should consider whether the presence of the limitation in Nagy '660 of R' being "C_6-C_{16} aryl," column 2, line 36, is sufficient to support the above terms in the application before us, particularly as the only disclosure in Reichle is that the corresponding group may be "hydrocarbon." See Reichle, column 3, lines 31-32.

Claim 71 is further directed to a limitation, "[w]here M is a Group 3 to 10 metal," which term has not been objected to by the examiner. The examiner should consider the meaning of groups 9 and 10, as the Periodic Table of the Elements generally contains only 8 groups, with the transition metals constituting Groups IIIB, to VIII and Groups IB and

IIB. The examiner should consider whether the disclosure in Nagy '660 relating to the polymerization of ethylene "using transition metal catalysts with bidentate ligands," is sufficient to support the scope of M in the present application, in light of the disclosure in Reichle that M is a metal selected from the group consisting of Group IIIB to VIII and Lanthanide series elements. See Reichle, claim 1.

As to the limitation in claim 71 with respect to X being directed to "C_{6-14} aryl, C_{7-20} alkaryl, C_{7-20} aralkyl," the only basis in Nagy '660 is directed to X being "alkyl." See column 2, line 38. Accordingly, as to the species of "aryl" disclosed by Reichle and unsupported in Nagy '660, Reichle would appear to be sufficient to establish a prima facie case of obviousness with respect to the claimed subject matter. The examiner should also consider whether the term "alkyl" provides support for the other identified species of X set forth in this paragraph.

APPROPRIATE ACTION

We remand this application to the examiner for action consistent with the above.

As a final point, we emphasize that we have only considered the merits of the examiner's rejection to the extent of the record before us. As the appellants have admitted on the record that, "[t]here is no question that there is a small but significant quantity of claimed subject matter not identically described in the parent application." Thus, Appellants may not be entitled to their parent application filing date under 35 U.S.C. §120," it is incumbent upon the examiner to consider at least each of the specific limitations enumerated above in order to determine whether the teachings of Reichle are

sufficient to establish a prima facie case of obviousness and whether the claimed subject matter fully complies with the requirements of Section 112, second paragraph with regard to the definition of M. See Brief, page 6. The fact that "appellants have not chosen to make this an issue herein," Brief, page 6, footnote 1, is not relevant to the issue at hand. We reiterate that the mere allegation by the examiner that "all of the claims are properly rejected under 35 USC [§] 103 as obvious over REICHLE," Answer, page 4, is not sufficient to establish a prima facie case of obviousness.

The examiner must consider whether there is basis in Nagy '660 for each of the newly inserted limitations in the instant application. In the event there is no basis in Nagy '660, the examiner must consider whether these limitations are suggested and taught by Reichle of record such that a prima facie case of obviousness is established with respect to the claimed subject matter.

DECISION

The rejection of claims 22 through 35, 37 through 51 and 53 through 73 under 35 U.S.C. §103(a) as being unpatentable over Reichle is reversed.

The decision of the examiner is reversed and this application is remanded to the jurisdiction of the examiner.

This application, by virtue of its "special" status requires immediate action. See Manual of Patent Examining Procedure (MPEP) § 708.01 (8th Ed., Aug. 2001). It is important that the Board be informed promptly of any action affecting the appeal in this application.

REVERSED and REMANDED

THOMAS A. WALTZ
Administrative Patent Judge)
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) BOARD OF PATENT
PAUL LIEBERMAN) APPEALS
Administrative Patent Judge) AND
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